

REMARKS

Applicant has carefully studied the Final Office Action of September 23, 2004, and offers the following remarks to accompany the above amendments.

Before addressing the rejections, Applicant provides a brief summary of the present invention and the references cited so that the remarks are considered in the proper context. The present invention relates to billing computer network users for the service that is actually provided to them. That is, a computer network user may contract for a certain quality of service (QoS1) from the computer network. The computer network is a network of computers that communicate with one another, typically via packets, such as are used in the internet protocol (IP). As such, the quality of service is primarily concerned with packet loss, but may also include bandwidth available, resource availability, and the like. The present system monitors the service actually received by the customer, and determines if the service received by the customer matches the service for which the customer contracted. If the quality of service actually received by the customer (QoS2) is different from the quality of service for which the customer has contracted (QoS1), the present invention allows the customer to be billed for the quality of service actually received (QoS2).

Claims 1, 2, 5, 7, 9, 11, 12, 13, 15, 18, 19 and 21 have been amended in the current response. Claims 1, 2, 5, 7, 11, 12, 13, 15, 18, and 21 have specifically been amended to recite the nature of the computer network and the communications between the computers on the computer networks. Claims 9 and 19 have been amended to clarify antecedent basis issues and make the claim terminology consistent throughout the claim set. No new matter is added.

Claims 1-4, 6-9, 11-15, 17-19, and 21 were rejected under 35 U.S.C. § 102(c) as being anticipated by Gallant et al. (hereinafter "Gallant"). Applicant respectfully traverses. For a reference to be anticipatory, the reference must disclose each and every claim element. Further, the elements of the reference must be arranged as claimed. MPEP § 2131.

Applicant previously argued that Gallant was not a computer network as that term was understood. The Patent Office responds by asserting that since Gallant discloses a computer at column 6, lines 30-35, that Gallant must be a computer network. Applicant disagrees with this analysis, and respectfully opines that no reasonable interpretation of the term "computer network" equates a cellular network or the PSTN with a single computer therein, as a "computer network". However, to preclude further confusion on what was intended by the term "computer

network", Applicant herein amends claims 1, 11, and 21 to further clarify the nature of the computer network as a network of computers that communicate with one another via the transmission of packets. In light of this clarification, it is readily apparent that Gallant's cellular network, that has a billing computer, is not a computer network as recited in the claims. As this point has been previously argued, it does not raise a new issue, require further consideration, or require a further search. MPEP § 904.

Applicant further traverses the assertion that Gallant is concerned with quality of service. Specifically, the Patent Office states that "Gallant further states that the service areas are determined on the basis of providing quality of service. (column 6, lines 49-59)." This statement is demonstrably not true. Gallant, column 6, lines 49-59 state in full:

When a subscriber purchases mobile telephone service from a mobile communication system, such as that shown in the example of FIG. 1, the subscriber is usually incognizant of and likely to be unconcerned with the physical layout of the various service area cells forming the service area and how topography, atmospheric and architectural conditions adversely affect the their effective shape and overall service quality. Consequently, the subscriber expects that a defined calling area on which service has been purchased will be invariant in size and shape and that the tariff rate for service within the calling area will be as equally predictable.

While the passage does use the term "service quality", there is nothing that indicates that the service area is actually determined by providing quality of service. Rather, the passage indicates that the service quality is affected by topography, atmospheric and architectural conditions. To this extent, Gallant does not deal with quality of service issues as recited in the claims, and as Applicant has previously argued. Since Gallant does not deal with quality of service issues, Gallant does not show the claim element, and Gallant does not establish anticipation of the claims.

The Patent Office, at the bottom of page 3 of the Office Action, states that Rahman teaches evaluating quality of service in which quality of service is a factor for providing billing to a subscriber. Applicant is uncertain as to what was intended by this observation. Typically, the references may not be combined in an anticipation rejection. That is, unless the supplementary reference proves the primary reference is enabling, explains the meaning of a term, or shows that a characteristic is inherent, only one reference should be used in an anticipation rejection. MPEP § 2131.01. If the Patent Office intended to use both Gallant and

Rahman in an anticipation rejection, such action is inappropriate, and Applicant requests withdrawal of the § 102 rejection.

If the Patent Office intended to reject the claims under 35 U.S.C. § 103 as being unpatentable over Gallant in view of Rahman, Applicant respectfully traverses such a rejection. For the Patent Office to combine references in an obvious rejection, the Patent Office must do two things. First, the Patent Office must articulate the motivation to combine the references. Second, the Patent Office must support the motivation to combine the references with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Even if the references are properly combinable, the combination must still teach or suggest each and every element of the claim. MPEP § 2143.03. The Patent Office opines that the combination would be obvious because "both provide billing for use of service over a network and it provides an efficient and measurable parameter for determining billing amount based on criteria subscribers place importance upon." There is no evidence supplied by the Patent Office to support the assertion of the motivation. Absent the evidence required by the Federal Circuit, the combination is improper. Since the combination is improper, the implied rejection is improper, and the claims are allowable.

Even if the combination is proper, (a point which Applicant does not concede) the combination does not show the computer network recited in the claims. As explained above, Gallant is a cellular phone network with a single computer, not a computer network. Likewise, Rahman is a wireless network, not a computer network as recited in the claims. Since the references individually do not teach or suggest the claimed invention, the combination of references cannot teach or suggest the claimed invention. Since the combination does not teach or suggest the claimed invention, the Patent Office has not established obviousness, and the claims are allowable.

Claims 5, 10, 16, and 20 are not specifically rejected in the present response. However, the Patent Office indicates that claims 1-21 stand rejected as stated in the previous office action, mailed April 8, 2004, and provides analysis as to why the taking of Official Notice is proper for claims 5, 10, 16, and 20. However, the provision of the Chen and Melen references raises a different question in an obviousness analysis. Specifically, to reject a claim under 35 U.S.C. § 103 as being obvious over a modified reference (such as when the Patent Office modifies a reference to include subject matter that is notoriously well known), the Patent Office must do

two things. First, the Patent Office must provide a motivation to modify the reference. Second, the Patent Office must provide actual evidence to support the motivation to modify the reference. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000).

In the Office Action of April 8, 2004, the Patent Office opined that that for claims 5 and 16, it would be obvious to modify the teachings of Gallant to include a packet detector to generate accounting records to determine packet loss, because it is an efficient manner to determine performance of the network in regards to service a subscriber is billed for. Applicant traversed the Official Notice, and the Patent Office responded with evidence to support the proposition that determining packet loss was known at the time of invention. However, the Patent Office still has not provided any actual evidence that a motivation is suggested, as required by *Kotzab*. Thus, even if determining packet loss was known, there is no evidence that the motivation announced by the Patent Office was known or desirable at the time of invention. Since the Patent Office has not provided the requisite actual evidence, the modification to Gallant for claims 5 and 16 is improper. Since Gallant absent modification admittedly does not teach or suggest the claim element, the Patent Office has not established obviousness. Since the Patent Office has not established obviousness, claims 5 and 16 are allowable.

Likewise, in the Office Action of April 8, 2004, the Patent Office opined that for claims 10 and 20, it would have been obvious to modify Gallant to include that the policies are deployed at the source and destination IP address, protocol, or destination port level, because it provides an efficient system to monitor a subscriber's service usage for billing procedures by tracking characteristics related to the subscriber's equipment. Again, Applicant traversed the Official Notice, and the Patent Office responded with evidence to show how the element was well known to support the proposition that accounting policies in computer networks were known at the time of invention. However, the Patent Office still has not provided any actual evidence to support the motivation of the modification to Gallant as required by *Kotzab*. Thus, even if determining accounting policies known, there is no evidence that the motivation announced by the Patent Office was known or desirable at the time of invention. Since the Patent Office has not provided the requisite actual evidence, the modification to Gallant for claims 10 and 20 is improper. Since Gallant, absent modification, admittedly does not teach or suggest the claim element, the Patent Office has not established obviousness. Since the Patent Office has not established obviousness, claims 10 and 20 are allowable.

Applicant requests reconsideration of the rejections in light of the remarks and amendments presented herein. Gallant does not teach a computer network that bills based on quality of service as recited in the claims. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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